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OCT 26 2006

PATENT

App. Ser. No.: 09/865,371

Atty. Dkt. No. ROC920010109US1

PS Ref. No.: IBMK10109

REMARKS

This is intended as a full and complete response to the Final Office Action dated September 5, 2006, having a shortened statutory period for response set to expire on December 5, 2006. Applicants submit this response to place the application in condition for allowance or in better form for appeal. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-46 are pending in the application. Claims 1-46 remain pending following entry of this response.

Claim Rejections - 35 U.S.C. § 103

Claims 1-46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bhat* (US 5,668,995) in view of *Cline et al.* (US 2002/0087897, hereinafter *Cline*). Applicants respectfully traverse this rejection.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143. The present rejection fails to establish at least the first and third criteria, as described below.

1. The Cited References

In the current rejection, the Examiner cites to *Cline* and *Bhat*. *Cline* is directed towards dynamically changing the performance of devices in a computer platform. *Cline*, Title. *Cline* describes monitoring and controlling individual device performance states of multiple devices in computer system. *Cline*, Pg. 1, Para. 0011. *Bhat* is

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directed to capacity planning system which provides a correctly sized and configured computer system in response to user specified requirements. *See Bhat*, Abstract. Thus, *Bhat* describes a method of automating the marketing and sales process to save time for salespersons. *See Bhat*, Col. 2, Lines 57-59.

2. There is no Suggestion or Motivation to Combine the Cited References

In the rejection, The Examiner suggests combining an alleged usage trend in *Cline* with *Bhat* to determine projected requirements for a computer system solution. *Final Office Action dated September 5, 2006* (hereinafter *Final Office Action*), Pg. 3. Accordingly, the Examiner has suggested a combination which combines monitoring aspects of *Cline* which are used to change performance states of devices in a computer system with aspects of *Bhat* which describe a capacity planning system for marketing and selling a computer system in response to user specified requirements.

The Examiner states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a system solution based on a usage trend taught by *Cline* with the system of *Bhat* because it would provide comprehensive control over operational states of a computer system. *Id.*

Applicants respectfully submit that the Examiner has not provided a suggestion or motivation to combine the cited references in the manner suggested. The combination suggested by the Examiner is one of monitoring aspects of *Cline* with marketing and sales aspects of *Bhat*. However, the motivation provided by the Examiner merely describes how aspects of *Cline* (performance monitoring) are used within *Cline itself*, to change performance states of devices in a computer system. *See Cline*, Abstract. Accordingly, the Examiner has not provided a suggestion or motivation to combine monitoring aspects of *Cline* with marketing and sales aspects of *Bhat*.

Therefore, Applicants respectfully submit that the first requirement of the *prima facie* case of obviousness has not been satisfied and withdrawal of the rejection is respectfully requested.

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3. The Cited References Do not Teach or Suggest All the Claim Limitations

The pending claims describe generating an operation profile for a computer using machine performance information specific to the computer and obtained from the computer, wherein the operation profile indicates at least a usage trend for the computer. The Examiner states that *Bhat* describes "generating an operation profile for a computer using machine information specific to the computer and obtained from the computer" in the Abstract of *Bhat*. *Final Office Action*, Pg. 2.

The Abstract of *Bhat* states that a capacity planning system provides a correctly sized and configured computer system in response to user specified requirements. See *Bhat*, Abstract; Col. 1, Lines 57-61. Thus, in *Bhat*, the capacity planning system assists a user through the process of sizing and configuring a computer system. *Bhat*, Col. 2, Lines 31-35. Accordingly, *Bhat* describes user input for a given client-server environment and, as depicted in Figure 2A, Item 26, the user is prompted for specifications. *Bhat*, Col. 3, Lines 6-14. Therefore, in *Bhat*, the user provides specified requirements for the computer system. *Bhat* does not describe configuring a computer system using information obtained from that same computer system.

Accordingly, *Bhat* does not describe generating an operation profile for a computer using machine performance information specific to the computer and obtained from the computer, wherein the operation profile indicates at least a usage trend for the computer. Therefore, the cited reference does not teach or suggest the subject matter asserted by the Examiner, and withdrawal of the rejection is respectfully requested.

4. The Cited References are Non-Analogous Art

To rely on a reference under 35 U.S.C. § 103, the reference must be analogous prior art. See MPEP § 2141.01(a). A reference is considered analogous prior art if the reference is either in the field of Applicants' endeavor or, if the reference is reasonably pertinent to the particular problem with which the inventor was concerned. *Id.* A

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reference is pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem. See *id.*, citing *Wang Laboratories v. Toshiba Corp.*, 993 F.2d 858 (Fed. Cir. 1993). Furthermore, when determining whether a reference is analogous, the Examiner cannot look at isolated teachings of the prior art without considering the over-all context within which those teachings are presented. *In re Pagliaro*, 657 F.2d 1219, 1225 (Cust & Pat.App., 1981). Thus, the Examiner must consider each reference as a whole and determine if the reference as a whole is concerned with problems associated with the pending application. *Id.*

As described above, *Bhat* is directed to assessing a customer's ongoing needs and matching those needs with an appropriate cost effect product configuration. *Bhat*, Col. 1, Lines 29-32. Thus, *Bhat* provides an automated marketing and sales process which provides a system configuration based on a specified set of user constraints. *Bhat*, Col. 2, Lines 57-59. Accordingly, *Bhat*, when viewed as a whole, is directed to marketing and selling of a computer system based on customer requirements specified by the customer.

In contrast, *Cline* is directed to conserving energy in a computer system using low-power states to reduce power consumption. *Cline*, Pg. 1, Para 0004, Para. 0006. Thus, *Cline* dynamically monitors performance states of devices in a computer system and controls performance states of the devices. *Cline*, Pg. 1, Para. 0011. *Cline* is solely directed towards dynamic operation and power consumption in a computer system. See generally, *Cline*. *Cline* does not mention customers, marketing, selling, purchasing, or upgrading of computer system. See *id.* Therefore, when viewed as a whole, *Cline* is not concerned with the problems of marketing and selling a computer system or providing product upgrades. See *id.* Accordingly, Applicants respectfully submit that *Cline* is not analogous prior art and cannot be relied on as a reference under 35 U.S.C. § 103. See MPEP § 2141.01(a). Therefore, withdrawal of the rejection and allowance of the claims is respectfully requested.

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Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

If the Examiner believes any issues remain that prevent this application from going to issue, the Examiner is strongly encouraged to contact Gero McClellan, attorney of record, at (336) 643-3065, to discuss strategies for moving prosecution forward toward allowance.

Respectfully submitted, and
S-signed pursuant to 37 CFR 1.4,

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